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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/820,554 | 03/29/2001 | Kazutoyo Maehiro | 6514-7 | 4973 |

7590 11/26/2003

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

DATE MAILED: 11/26/2003

Handwritten signature

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/820,554

Applicant(s)
Maehiro

Examiner
Susan Chen

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2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 15, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 11 6) ☐ Other:

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DETAILED ACTION

1. This is in response to amendment filed on 09/15/2003.
2. Claims 1 - 30 are pending for examination, claims 1, 5, 8, 11-13, 15-16, 18, 20-21, 23, 26-27 and 30 have been amended, and claim 31 has been canceled .
3. Acknowledgment is made of the claim for foreign priority under 35 U.S.C. § (a)-(d) or (f). All of the certified copies of the priority documents have been received and the priority claim is accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-30, are rejected under 35 U.S.C. 102(b) as being anticipated by MacNaughton et al. (U.S. Patent No. 5,769,393).

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6. As to claims 1, 14-16 and 29-31, MacNaughton et al. (hereinafter referred as MacNaughton) discloses a computer system [e.g., see Abstract, Fig. 1] with apparatus, methods and computer program products as claimed by applicant, to perform the following processing, comprising:

a) a membership information retrieval server [e.g., see the Community Server (18), Fig. 1] accepts requests from a group of user terminals [e.g., see the user's terminal with Web browser (10), Fig. 1] via the Internet communication protocols [e.g., TCP/IP (16, 34), or HTTP or FTP or IRC, etc; col. 6, lines 35-37] to perform the following functions, comprising:

- * storing the membership information from a group of users to a storage device [e.g., see col. 8, lines 24-33; the Membership Database (44), Fig. 1B];

- * extracting and searching selected membership information from the storage device in respond to the request [e.g., see the Who's Online service provided by the community server; col. 7, lines 5-6] from the system user [col. 1, lines 54-61; col. 8, lines 10-23; col. 9, lines 41-45];

- * displaying the membership information sent from the server on display of the user terminals [col.2, lines 19-23];

- * communicating to one or more members in the created temporary user list via messages flow between a client/server model [Fig (s) 4-5]. [e.g. see the "who's Online" and "Invitation" functional processing cited at col. 16, lines 15 - 59; col. 18, lines 42-51; col. 21,

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lines 36-45, wherein a second temporary user list that is associated with the invitation action can be created by using extended scripting language].

As to claims 2-13 and 17-28, MacNaughton further discloses that the system having the features as claimed by applicant, including:

a) a determination system [e.g., 148, Fig. 4] that determines whether each of the group of the user terminals is current online [e.g., see 150, Fig. 4], wherein the communication server [e.g., 140, Fig. 4] imports the determination results into the membership information and then sends the membership information to the user terminal [col. 8, lines 43-65; Fig. 4; col. 16, lines 15 - 48];

b) the membership information includes user name, text , etc, which can be updated whenever necessary from the user terminal online [col. 8, lines 29-39].

Response to Arguments

7. Applicant's arguments filed on 09/820,554 have been fully considered but they are not persuasive.

With respect to U.S.C. 102(e) rejection, Applicant states on page 12, the prior art on record including Macnaughton "only analyzes whether a user is online, and does not search membership information".

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In response to this argument, the examiner point out that Macnaughton specific discloses that his system includes a Tracking server [148] which could stripping a user identifier that may be associated with a system action and maintains a list of current users in the memory that may be interrogated by the community server 140 on behalf of a client. [e.g. see the "Who's Online service" (col. 7, lines 9-10) & col. 16, lines 27-34]. Furthermore, Macnaughton expressly discloses his system provides the function of searching and listing of member/members currently in the community [col. 9, lines 41-44; CwhoIsHereTrackReq() & CwhoIsHereTrackRsp() functions at col. 17], wherein the list clearly contains the membership information of a system user. As such, the examiner regards the prior reads on the claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen, whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group is: (703) 872-9306.

11. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Nov 18, 2003


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